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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/041,039	12/28/2001	Carl I. Green	42390.P13009	1948

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EXAMINER

NELSON, ALECIA DIANE

ART UNIT	PAPER NUMBER
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2675

DATE MAILED: 10/02/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/041,039

Applicant(s)

GREEN, CARL I.

Examiner

Alecia D. Nelson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. **Claim 3** is objected to because of the following informalities: **Claim 3** depends upon itself. It appears that this is a typographical error. The examiner will reject **claim 3** as being dependent from **claim 2**. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. **Claims 1-3, 6, 9, and 10** are rejected under 35 U.S.C. 102(e) as being anticipated by Ano (U.S. Publication No. 2002/0030665).

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With reference to **claims 1 and 9**, Ano teaches a portable information device (1) including an input device (4) wherein a wheel (8) is positioned horizontally relative to the keyboard surface of the portable computer (1) (see paragraphs 93-94), wherein rotation of the wheel (8) communicates user input to the computer (see paragraphs 99-101).

With reference to **claims 2 and 10**, Ano teaches that the wheel is positioned below a space bar (not labeled) of the keyboard (4) surface, substantially in a center of the keyboard (see Figures 1-2).

With reference to **claim 3**, Ano teaches that the wheel (8) includes a tracking device (18) to provide user input to direct a cursor (35) displayed on a display of the portable computer (see paragraphs 99-101).

With reference to **claims 4 and 11**, Ano teaches a tracking device (5) is placed substantially in a center of the wheel (8) (see Figures 1-2). With further reference to claim 11, it is also taught that the tracking device (5) provides user input to direct a cursor displayed on a display of the portable computer (see figure 107).

With reference to **claims 6 and 15**, Ano teaches that the wheel is rotated in the clockwise direction to cause the displayed information to scroll downward in the window screen (30), and rotated in the counterclockwise direction to cause the displayed information to scroll upward in the window screen (30) (see paragraphs 100-101).

With reference to **claim 14**, Ano teaches a portable information device (1) including an input device (4) wherein a wheel (8) is positioned horizontally relative to the keyboard surface of the portable computer (1) (see paragraphs 93-94). Ano also teaches that the wheel is positioned below a space bar (not labeled) of the keyboard (4) surface, substantially in a center of the keyboard (see Figures 1-2), wherein rotation of the wheel (8) communicates user input to the computer (see paragraphs 99-101). The wheel (8) includes a tracking device (18) to provide user input to direct a cursor (35) displayed on a display of the portable computer (see paragraphs 99-101), wherein the tracking device (5) is placed substantially in a center of the wheel (8) (see Figures 1-2).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claim 5** is rejected under 35 U.S.C. 103(a) as being unpatentable over Ano.

With reference to **claim 5**, Ano fails to specifically teach that the wheel includes ridges to provide friction. However, it can be seen in Figure 2, that the wheel includes some type of ridges around the wheel device.

Therefore it would have been obvious to one having ordinary skill in the art to include such ridges, or a surface that is not smooth, in order to prevent slippage of the

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user's finger across the surface of the wheel when rotating the wheel to control the displayed information.

6. **Claims 7, 8, 12, 13, and 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ano as applied to **claims 1, 9, and 14** above, and further in view of Douglas (U.S. Patent No. 5,156,049).

With reference to the claims Ano fails to teach that the rotation of the wheel provides variable input to an application being executed on the computer. It is taught that the wheel is capable of being used to move images, browse through frames of images, as well as control the vertical tool bar (see paragraphs 100-102). Moreover, it would be obvious to allow the wheel to control variable input as of function of the application be executed.

Douglas teaches a manual input system wherein a computer (23) drives a plurality of displays (31, 33, 35, 37), wherein each display includes a three-digit, seven segment display (39). Located below the respective displays are knobs (13, 15, 17), wherein each knob has associated indicia indicating the proper direction of rotation for increasing the corresponding parameter, and rotating the knob in the opposite direction decreases the parameter (see column 4, lines 18-56).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention for the wheel device of Ano to be capable of providing variable input wherein rotation in one direction causes the variable to increase and rotation in the opposite direction causes the variable to decrease, as taught by Douglas to thereby

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allow for applications including numerical data to be controlled by rotation of the wheel device. This thereby allows the user to control more functions with out having to change hand placement.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alecia D. Nelson whose telephone number is (703)305-0143. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Saras can be reached on (703)305-9720. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9314 for regular communications and (703)308-9051 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-4700.

adn/ADN
September 24, 2003


DENNIS-DOON CHOW
PRIMARY EXAMINER